

### **Remarks**

Claims 10, 11, 18, 20 and 21-182 will be pending upon entry of this amendment. New claims 21-182 have been added to expand the embodiments of the provisionally elected subject matter (see below).

New claims 21-168 find support in the claims as originally filed and throughout the specification. For example, support for new claims 21(a), 21(b), 22, 23, 48(a), 48(b), 49, 50, 75(a), 75(b), 76, 77, 102(a), 102(b), 103, 104, 129(a), 129(b), 130, 131, 156(a), 156(b), 157, and 158, is found, for example, in the specification at page 4, lines 23-31. Support for claims 21(c), 21(d), 25, 26, 48(c), 48(d), 51, 52, 75(c), 75(d), 78, 79, 102(c), 102(d), 105, 106, 129(c), 129(d), 132, 133, 156(c), 156(d), 159, and 160, is found, for example, in the specification at page 11, lines 3-14. Support for claims 21(e), 27, 48(e), 53, 75(e), 80, 102(e), 107, 129(e), 134, 156(e), and 161, is found, for example, in the specification at page 5, lines 1-10. Support for claims 21(f), 48(f), 75(f), 102(f), 129(f), and 156(f), is found, for example, in the specification at page 4, lines 23-31 and at page 17, lines 32-33. Support for claims 21(g), 28, 48(g), 54, 75(g), 81, 102(g), 108, 129(g), 135, 156(g), and 162, is found, for example, in the specification at page 4, lines 23-31 and page 5, lines 1-10. Support for claims 21(h), 29, 48(h), 55, 75(h), 82, 102(h), 109, 129(h), 136, 156(h), and 163, is found, for example, at page 6, line 26, through page 7, line 8, and at page 8, lines 27-32. Support for claims 21(i), 21(j), 30, 31, 48(i), 48(j), 56, 57, 75(i), 75(j), 83, 84, 102(i), 102(j), 110, 111, 129(i), 129(j), 137, 138, 156(i), 156(j), 164, and 165, is found, for example, in the specification at page 11, lines 3-14.

Thus, no new matter has been introduced.

### **Provisional Election**

The Examiner has required restriction of the claimed subject matter into one of ~~six~~ six different groups. In order to be fully responsive, Applicants hereby provisionally elect, with traverse, the subject matter of Group I, represented by new claims 21-182. Applicants reserve the right to file one or more divisional applications directed to non-elected subject matter should the restriction requirement be made final. In such case, Applicants retain the right to petition from the restriction requirement under 37 C.F.R. § 1.144.

Applicants respectfully traverse and request the withdrawal of the Restriction Requirement.

As a threshold matter, Applicants point out that MPEP § 803 lists the criteria for a proper restriction requirement:

Under the statute an application may properly be required to be restricted to one of two or more claimed inventions only if they are able to support separate patents and they are either independent (MPEP § 806.04 – § 806.04(i)) or distinct (MPEP § 806.05 – § 806.05(i)).

If the search and examination of an entire application can be made without serious burden, the examiner must examine it on the merits, even though it includes claims to independent or distinct inventions.

Thus, even assuming, *arguendo*, that the groups listed by the Examiner represented distinct or independent inventions, restriction remains improper unless it can be shown that the search and examination of both groups would entail a “serious burden.” *See* M.P.E.P. § 803. In the present situation, no such showing has been made.

Applicants submit that a search of the sequence of Group I would provide useful information for the sequences of the other Groups. For example, a search of claims to gene therapy, as designated by Group IV, would clearly overlap with a search of the polynucleotides and constructs encompassed by Group I. Similarly, a search of the subject matter of Group V, drawn to a diagnostic procedure using hybridization, would overlap with a search of Groups I and II. Therefore, the search and examination of at least Groups I, II, and V, together, if not all of the groups, would not entail a serious burden.

Thus, Applicants respectfully request that the Restriction Requirement be withdrawn so the subject matter of all the groups can be examined together.

### **Conclusion**

Applicants respectfully request that the above-made amendments and remarks be entered and made of record in the file history of the instant application. Applicants believe that this application is in condition for substantive examination. If in the opinion

of the Examiner, a telephone conference would expedite prosecution, the undersigned can be reached at the telephone number indicated below.

If there are any fees due in connection with the filing of this paper, please charge the fees to Deposit Account No. 08-3425.

Respectfully submitted,

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